



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,653	03/01/2004	Wing K. Lee	IDF 2532 (4000-15300)	9564
28003	7590	09/15/2006	EXAMINER	
SPRINT 6391 SPRINT PARKWAY KSOPHT0101-Z2100 OVERLAND PARK, KS 66251-2100			ALLEN, WILLIAM J	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 09/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/790,653	Applicant(s) LEE ET AL.	
	Examiner William J. Allen	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/2/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-7, drawn to a marketplace for providing web services, classified in class 705, subclass 26.
 - II. Claims 8-24, drawn to a web service marketplace, classified in class 705, subclass 26.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I are II related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as a storage component operable to maintain information related to a web service and a pointer related to the information, the pointer including an Internet protocol address. See MPEP § 806.05(d).
3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Art Unit: 3625

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

During a telephone conversation with Steven Funk and Michael Piper on September 11, 2006 a provisional election was made without traverse to prosecute the invention of group II, claims 8-24. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-7 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application for the reasons listed on PTO form 948 (see attached PTO-948). Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Objections

Claim 16 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 16 recites "wherein the customer is further defined as a consumer". The Examiner notes that, according to Webster's New Riverside Dictionary, a customer is defined as a person who buys goods from whom one must deal, and a consumer is defined as one that consumes, a buyer of goods and services. Thereby, to define a customer as a consumer does not further limit the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 8-9, 11-12, 15-19, and 23-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Pallister et al. (US 20030195813, herein referred to as Pallister).**

Regarding claims 8 and 18, Pallister teaches a system and method for selling web services based on the quality of service comprising:

providing an electronic marketplace system for selling web services (see at least: abstract, Fig. 1);

offering, by a plurality of providers, web services via the electronic marketplace system based on a quality of service for the web service (see at least: 0028, Fig. 2-3, claim 16); The Examiner notes that accuracy, reliability, bandwidth, capacity, security, etc. represent qualities of service.

obtaining, by one or more customers via the electronic marketplace system, the web services having the quality of service for the web service from one or more providers (see at least: 0027, 0029-0030, Fig. 2-3).

Art Unit: 3625

Regarding claims 9, 11-12, 15-17, 19, and 23-24, Pallister teaches:

(9) wherein the offering component identifies a plurality of web services by a plurality of providers (see at least: abstract, 0014).

(11) wherein the offering component includes a price associated with each of the one or more web services offered (see at least: 0006-0007, 0015, 0017, 0020, 0023, 0024-0025, 0028-0031, 0033, claim 16).

(12) wherein the offering component includes a quality of service related to each of the web services (see at least: 0028, 0031, claim 16).

(15) wherein the customer is further defined as a business with offerings to customers associated with the web services (see at least: 0004-0006, 0014).

(16) wherein the customer is further defined as a consumer (see at least: 0004-0006, 0014-0024).

(17) wherein the customer is further defined as an entity utilizing the web service (see at least: 0004-0006, 0014).

(19) offering, by one of the providers, a particular web service at a price and accepting, by one of the customers, the offer of the web service at the price and quality of service for the web services (see at least: 0028-0029, Fig. 2-3).

(23) wherein the web services are further defined as based on a web services standard (see at least: abstract, 0005, 0007, 0015, 0019).

(24) wherein the web services are further defined as reusable components operable for providing a service via the internet (see at least: 0020).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 10, 13, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pallister in view of Hartsell et al. (US 20020049608, herein referred to as Hartsell).**

Regarding claim 10, Pallister teaches all of the above as noted and further teaches where providers are compensated for the services and functionality they provide (see at least: 0005). Pallister, however, does not expressly teach *a financial component operable for the customer to compensate the provider for the web services obtained*. Hartsell teaches *a financial component operable for the customer to compensate the provider for the web services obtained* (seen at least: 0012, 0015, 0095, 0302, 0325, Fig. 7). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Pallister to have included *a financial component operable for the customer to compensate the provider for the web services obtained* as taught by Hartsell in order to provide competitive service differentiation and enhanced revenue generation (see at least: Hartsell, 0302).

Art Unit: 3625

Regarding claim 13, Pallister teaches all of the above as noted and further teaches providing different qualities of service (see at least: 0028, 0031, claim 16). Pallister, however, does not expressly teach *wherein the quality of service is further defined as a guaranteed quality of service*. Hartsell teaches *wherein the quality of service is further defined as a guaranteed quality of service* (see at least: 0013, 0101, 0326). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Pallister to have included *wherein the quality of service is further defined as a guaranteed quality of service* as taught by Hartsell in order to provide an overall network infrastructure the ability to provide differentiated services in accordance with business objectives (see at least: Hartsell, abstract, 0013).

Regarding claim 20, Pallister teaches all of the above as noted and further teaches providing different qualities of service with a wide variety of offerings. (see at least: 0007, 0024-0025, 0033). Pallister, however, does not expressly teach *wherein at least one of the web services are offered by one of the providers at a first price based on a first quality and a second price based on a second quality*. Hartsell teaches *wherein at least one of the web services are offered by one of the providers at a first price based on a first quality and a second price based on a second quality* (see at least: 0013, 0101, 0326). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Pallister to have included *wherein at least one of the web services are offered by one of the providers at a first price based on a first quality and a second price based on a second quality* as taught by Hartsell

Art Unit: 3625

in order to provide an overall network infrastructure the ability to provide differentiated services in accordance with business objectives (see at least: Hartsell, abstract, 0013).

8. Claims 14 and 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pallister in view of Lao et al. (US 20030220880, herein referred to as Lao).

Regarding claim 14, Pallister teaches all of the above as noted and further teaches a web service provider providing businesses with web services (see at least: 0005, 0014). Lao discloses where a company, such as Company ABC, creates (i.e. develops) and sells (i.e. provides) authoring applications to (see at least: 0172, Fig. 22-23), thereby teaching where a *provider* is further defined as a *developer*. It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Pallister to have included where a *provider* is further defined as a *developer* as taught by Lao in order to provide an improved system and method for licensing of networked services, such as Web services, and the like (see at least: Lao, 0007).

Regarding claim 22, Pallister teaches all of the above as noted and further teaches binding a customer to a web service and allowing limited use, pay per use, etc. of the obtained web service by the customer (see at least: 0020, 0030). Pallister, however, does not expressly teach providing *a license agreement accessible via the electronic marketplace system, the license agreement related to use by the customer of the web service obtained from the provider*. Lao teaches providing *a license agreement accessible via the electronic marketplace system, the*

Art Unit: 3625

license agreement related to use by the customer of the web service obtained from the provider (see at least: abstract, 0003, 0007, 0038, 0041-0050, 0055-0058, 0062, 0066, Fig. 2-3, 6, and 11).

It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Pallister to have included *a license agreement accessible via the electronic marketplace system, the license agreement related to use by the customer of the web service obtained from the provider* as taught by Lao in order to provide an improved system and method for licensing of networked services, such as Web services, and the like (see at least: Lao, 0007).

9. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pallister in view of Powers (US 20020035521).

Regarding claim 21, Pallister teaches all of the above as noted and further teaches receiving bid offers (i.e. quotes) for web services through an auction system (see at least Fig. 2-3). Pallister also teaches where the user identifies criteria such as price or various qualities of service which they feel are most important (see at least: 0028, claim 16). Pallister however, does not expressly teach *wherein at least one of the web services are offered by one of the providers at an undetermined quality of service* Powers teaches where a price quote is received from a service center with a price and time stamp, wherein a user can select to be shown only the quote with the lowest price (i.e. the determining factor is only price). Thereby an offer is received and selected from a service center for which a quality of service has not been determined and price is the only determining factor (see at least: 0045, 0047, Fig. 2B). It would have been obvious to one of

Art Unit: 3625

ordinary skill in the art at the time of invention to have modified the invention of Pallister to have included *wherein at least one of the web services are offered by one of the providers at an undetermined quality of service* as taught by Powers in order to receive and sort offers from service providers that best fit predetermined criteria of a user (see at least: Powers, 0047; Pallister, 0017, 0020).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. PTO 892 reference U discloses web service developers/providers providing low cost web services.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Allen whose telephone number is (571) 272-1443. The examiner can normally be reached on 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William J. Allen
Patent Examiner
September 12, 2006


Primary Examiner